REMARKS

The Examiner is thanked for the very thorough and professional Office Action. Pursuant to that action, Claims 5, 8 and 10 have been amended to more definitely set forth the invention and obviate the rejection. Specifically, Claim 5 has been amended to set forth a group using Markush terminology, Claim 8 has been amended to delete the term "type of " objected to by the Examiner, and Claim 10 has been amended to delete the objectionable phrase "in sequence". The present amendment is deemed not to introduce new matter. Claims 1, 3, 5-8 and 10-21 remain in the application.

Reconsideration is respectfully requested of the objection to Claims 5, 8 and 10. These claims have been amended in the manner suggested by the Examiner. It is therefore believed that the objection is moot. Withdrawal of the objection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 1, 3, 6-8 and 11 under 35 U.S.C. § 102(e) as anticipated by Baba, et al.

In the Office Action Summary, PTOL-326, the Examiner has acknowledged priority for the present application under 35 U.S.C. § 119(a)-(d) or (f). However, there appears to be no acknowledgement of applicants' claim for priority under 35 U.S.C. § 365 which was filed with the application on December 31, 2003. A copy of this claim for priority is attached for the Examiner's convenience. In applicants' claim for priority, applicants claimed the benefit of the filing date of Japanese patent application No. 11/241599 filed August 27, 1999. In support of that claim for priority applicants stated that a certified copy of the original foreign application was filed with the International Bureau on September 27, 2000 as evidenced by Form PCT/1B/304 which was attached

A confirmation number 4222, 371 Acceptance Letter, was mailed on 04/01/2002 granting the present application a priority date of 08/27/1999, copy attached. It is therefore believed that the present application satisfied all of the requirements of 35 U.S.C. § 365, and is entitled to a priority date of 08/27/1999 as per the 371 Acceptance Letter. In addition, the filing receipt in this office action grants a domestic priority date under 371 of 08/24/2000 and the foreign application date of 08/27/1999. Consequently, under 35 U.S.C. § 365, it is believed that the present application is entitled to the right of priority based upon the prior foreign Japanese application as per 35 U.S.C. § 365(b).

It is respectfully requested that there be an indication by the Examiner that the requirements of 35 U.S.C. § 365 have been fulfilled.

In determining whether Baba, et al. would apply under 35 U.S.C. § 102(e), MPEP 706.02(a) provides that the filing date of a patent granted on a 35 U.S.C. § 371 (PCT) application is the date on which paragraphs (1), (2) and (4) of the 35 U.S.C. § 371 application have been fulfilled.

In the present application, the Examiner has provided no evidence as to when paragraphs (1), (2) and (4) of 35 U.S.C. § 371 were fulfilled with respect to Baba, et al., and there does not appear to be any evidence of record in this case as to whether these conditions were ever fulfilled. Therefore, it is respectfully submitted that absent some indication as to when these three paragraphs of 371 requirements (1), (2) and (4) were fulfilled, Baba, et al. should be entitled only to its U.S. filing date of June 12, 2000. Therefore, based on the information provided by the Examiner, it is respectfully submitted that the Baba, et al. reference is not prior art against the present application which has an earlier effective filing date of 08/27/1999 as opposed to the filing date of Baba, et al. of January 12,

2000. On the basis of this information, it is respectfully submitted that Baba, et al. is not prior art against the present application under 35 U.S.C. § 102(e). Withdrawal of the rejection is accordingly respectfully requested.

In any event, it is respectfully submitted that Baba, et al. neither anticipates nor renders unpatentably obvious the subject matter called for in the claims herein. In particular, the inventive composition of the present invention comprises:

(A) a compound having at least two hydrolysable silyl groups in a molecule;

(B) a compound which initiates crosslinking of the compound (A);

(C) a compound having a polymerizable group in a molecule;

(D) a compound which is activated by irradiation to initiate polymerization of the polymerizable group in the compound (C); and

(E) a thixotropic agent.

In the composition of the present invention, both a cationic polymerization and radical polymerization are utilized for curing. Thus, both of these types of reaction proceed, for example, during a radiation with ultraviolet light. After the irradiation is stopped, cationic polymerization still proceeds to effect curing of the composition even though radical polymerization has stopped. Therefore, the composition of the present invention can be used in joining members placed in a dark environment.

In Baba, et al. relied upon by the Examiner, there is disclosed in Claim 1, for example, a composition used for coating which comprises:

(A') a polyfunctional (meth)acrylic compound containing at least three (meth)acryloyl

groups in a molecule,

(B') cosslinkable inorganic particles,

(C') a radiation curable acrylic resin having a Tg of 50°C or higher,

(D') a radiation polymerization initiator,

(E') a non-reactive solvent.

Baba, et al. in column 3, lines 15-38, discloses the use of alkoxy silane compounds in preparing the crosslinkable inorganic particles. The alkoxy silane is used to introduce into the inorganic particles a crosslinkable group such as shown in formula (1), column 3, lines 21-34, or else a urethane linking group. In the thus obtained crosslinkable inorganic particles, the silyl group is substituted with such crosslinking groups. Therefore, the resultant inorganic particles B disclosed in Baba, et al. does not have an alkoxy silyl group.

Moreover, none of the prior art of record discloses anything about using both radical and cationic polymerization. Further, the composition in Baba, et al. does not comprise cationic polymerization compounds, i.e., the compound B used in the present invention. Thus, after irradiation with UV light, the polymerization process in the Baba, et al. reference stops.

The preparation of the alkoxy silane compound disclosed in Preparation 1 in column 17, lines 50-67, and the preparation of component (B) disclosed in column 18, lines 1-15, illustrate the crosslinkable inorganic particles of Baba, et al. There it can be seen from the examples as illustrated in Tables 1 and 2 that there is no disclosure that the obtained inorganic particles (B) have an alkoxy silane group unreacted which would release or initiate crosslinking of the compound (A). Therefore, it is respectfully submitted that one skilled in the art upon analyzing the reaction scheme and

preparation examples 1 and 2 would reasonably conclude that the crosslinkable inorganic particles do not have alkoxy silyl groups which initiate crosslinking of the compound (A).

It is therefore respectfully submitted that the reaction components disclosed in Baba,et al. do not anticipate or render unpatentably obvious the composition of the present invention which relies on both cationic and radical polymerization in curing the composition. Absent such dual curing processes, the composition of Baba, et al. would be unsuitable for use as an adhesive in the absence of ultraviolet light.

With regard to the Examiner's discussion of the Doctrine of Inherency, it is respectfully urged that that doctrine does not apply in the present case because there is no disclosure in Baba, et al. of the basic elements of the composition as called for in the claims herein. Therefore, the Examiner would be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Fujita, et al. in view of Baba, et al.

The Baba, et al. reference is discussed above.

It is respectfully submitted that Fujita, et al. does not supply the deficiencies of Baba, et al. As the Examiner recognizes, Fujita, et al. fails to disclose the addition of a compound in the coating composition that initiates polymerization upon activation by irradiation corresponding to component (D) in the composition called for in the claims herein. Moreover, there is no disclosure in Fujita, et al. of the compound (B) of the present invention which initiates crosslinking of the compound (A). That is, a composition in which both cationic and radical polymerization are utilized in the curing of

the composition. In this regard it is respectfully submitted that neither Baba, et al. nor Fujita, et al. taken alone or in combination disclose or suggest that these references can be combined in the manner suggested by the Examiner to arrive at the composition now called for in the claims herein.

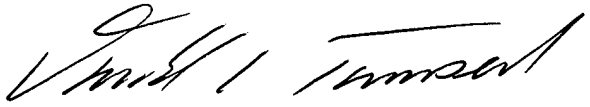
It is also respectfully submitted even if the references were combined, one skilled in the art would not arrive at the composition of the present invention which utilizes both cationic and radical polymerization for curing. That teaching or suggestion comes only from the present application and constitutes an important element or aspect of the present invention.

Failing the disclosure of components which performed very specific functions of dual polymerization, both cationic and radical polymerization, it is respectfully submitted that the Examiner would be justified in no longer maintaining this rejection. Withdrawal of the rejection is accordingly respectfully requested.

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance and early action and allowance thereof is accordingly respectfully requested. In the event there is any reason why the application cannot be allowed at the present time, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems.

Respectfully submitted

TOWNSEND & BANTA



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